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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/840,032   | 05/05/2004  | William M. Forti     | 100444.0018US1      | 7759             |
| 34284  | 7590        | 09/26/2005           | EXAMINER            |                  |
| ROBERT D. FISH<br>RUTAN & TUCKER LLP<br>611 ANTON BLVD 14TH FLOOR<br>COSTA MESA, CA 92626-1931 |             |                      | MILLER, BENA B      |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3725                |                  |

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/840,032 | <b>Applicant(s)</b><br>FORTI ET AL. |  |
|                              | <b>Examiner</b><br>Bena Miller       | <b>Art Unit</b><br>3725             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

*Bena B. Miller*

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 are finally rejected under 35 U.S.C. 102(b) as being anticipated by

Ming

Regarding claim 1, Ming teaches in the figures a flying toy comprising a head portion (4) and a spiral-shaped tail (5).

Regarding claim 2, Ming further teaches an elastic ball (4).

Regarding claim 3, Ming further teaches an engaging element (4).

Regarding claim 4, Ming further teaches a coil shape (fig.8).

Regarding claim 5, Ming further teaches a stepped spiral (fig. 8).

Regarding claim 6, Ming further teaches a portion (41).

Regarding claim 7, Ming further teaches a metal wire (fig.8).

Regarding claim 8, the examiner takes the position that the weight ratio between the head portion and the spiral-shaped tail of Ming is between 20:1 and 1:1.

Claims 1, 3-8 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Pacza (US Patent 6,361,395).

Regarding claim 1, Pacza teaches in the figures a flying toy comprising a head portion (12) and a spiral-shaped tail (14).

Art Unit: 3725

Regarding claim 3, Pacza further teaches an engaging element (16).

Regarding claim 4, Pacza further teaches a coil shape (fig.1).

Regarding claim 5, Pacza further teaches a stepped spiral (fig. 8).

Regarding claim 6, Pacza further teaches a portion (fig.1).

Regarding claim 7, Pacza further teaches a metal wire (col. 2, line 3).

Regarding claim 8, the examiner takes the position that the weight ratio between the head portion and the spiral-shaped tail of Pacza is between 20:1 and 1:1.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-16 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Ming.

Ming teaches in the figures most of the elements of the claimed invention except for instructions. It is well known in the art to provide instructions with a toy in order to instruct a person on how to use the toy. It would have been considered a mere design choice to provide instructions with the toy of Ming for the purpose of instructing a person on how to use the toy.

Claims 9 and 11-16 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Pacza.

Art Unit: 3725

Ming teaches in the figures most of the elements of the claimed invention except for instructions. It is well known in the art to provide instructions with a toy in order to instruct a person on how to use the toy. It would have been considered a mere design choice to provide instructions with the toy of Pacza for the purpose of instructing a person on how to use the toy.

### ***Response to Arguments***

Applicant's arguments filed 01/18/05 have been fully considered but they are not persuasive. Applicant's argument that Ming fails to teach the intended use of the claims, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this instance, Ming teaches that the under adhesion, spring extension and torque, weight gravitation will produce irregular continuous rolling, swinging and jumping (col. 2, lines 59-62). Applicant's attention is directed to the above rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3725

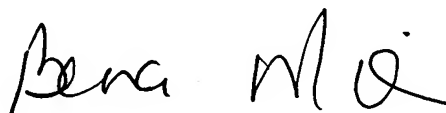
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bena Miller whose telephone number is 703.305.0643. The examiner can normally be reached on Monday-Friday.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3725

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Bena Miller", is positioned above the printed name.

Bena Miller  
Examiner  
Art Unit 3714

bbm  
September 21, 2005